

I hereby certify that this correspondence is being facsimile transmitted to: Commissioner for Patents, Washington, D.C. 20231 at (703) 305-2042 in accordance with 37 CFR §§ 1.6(d) and 1.8 on November 2, 2001.

Dora M. Kendall
Name of Attorney

63,709

Confirmation No.

Signature of Attorney

Case 7670

#9
MQ
11/3/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of :

D. N. RUBINGH ET AL. :

Confirmation No. 8554

Serial No.: 09/618,235 :

Group Art Unit: 1652

Filed: July 18, 2000 :

Examiner: W. M. Moore

Title: PROTEASE CONJUGATES HAVING :

STERICALLY PROTECTED EPITOPE REGIONS :

RESPONSE TO RESTRICTION REQUIREMENT/ELECTION OF SPECIES

Assistant Commissioner for Patents

Washington, D.C. 20231

Dear Sir:

This is responsive to the Office Action mailed on October 2, 2001, setting a one month period for response.

The Examiner states that restriction to one patentably distinct species of inventions is required under 35 USC §121. The Examiner states that while the claim structure does not, even in claims 3 and 4, acknowledge the need for substitutions at the great majority of positions recited in claims 1 and 12, and nowhere acknowledges the range of substituents that may be employed for covalent attachment, substituents for which the application provides an adequate written description, cysteine and lysine, are the basis for calculation of the following species:

Claims 1-21 are generic to a plurality of disclosed patentably distinct species comprising 178 species of singly-substituted and conjugated subtilisins and about 10,056 doubly-substituted and conjugated subtilisins where no doubly-substituted and conjugated subtilisins have both substitutions in a common epitope region. The Examiner goes on to state that there are "many, many more species that are represented in subtilisins wherein double substitutions for conjugation reside in one of the regions described by clauses (a), (b), and (c) of claim 1, and triply-substituted and conjugated subtilisins, fourfold-substituted and conjugated subtilisins and higher order substitutions and conjugations of subtilisins constitute a galaxy of species". Applicants have consequently been required under 35 USC §121 to elect a single disclosed species, identifying the number and location of position(s) wherein (a) substitution(s) is/are made for conjugation. Applicants traverse this election of species.

7670

09/618,235

Applicants respectfully submit that that such a restriction and election of species requirement is improper in this instance. Applicants base this assertion on the fact that each of the positions that are claimed as suitable for attachment in the protease conjugate of the present invention are not enumerable and are so closely related that it would not present an undue burden on the examiner to examine the art based on those specific positions.

In the event that the Examiner's election is made final, Applicants hereby provisionally elect epitope protection positions for the first epitope region of 17 and 89, 52 and 134 for the second epitope region, and 155 and 265 for the third epitope region, wherein each can be secondary to the other. Applicants reserve the right to pursue each of the non-elected species in one or more divisional applications.

Respectfully submitted,

By 

Dara M. Kendall

Attorney for Applicants

Registration No. 43,709

Tele. No.: (513) 626-1789

November 2, 2001
Customer No. 27740

NOV-02-2001 16:02

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FAX RECEIVED

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GROUP 1600

Fax

To:	Examiner William Moore	From:	Dara M. Kendall
Fax:	703-308-0583	Pages:	4 (Including cover sheet)
Phone:	703-308-4242	Date:	November 2, 2001
Re:	Response to Restriction Requirement/Election of Species in U.S. Serial No. 09/618,235		
	P&G Case 7670		

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Dear Examiner Moore:
Following please find a response to the restriction requirement/election of species mailed on October 2, 2001. If you should have any questions or concerns, please feel free to contact me at the numbers listed above.

Regards,

Dara M. Kendall
Attorney for Applicants
Reg. No. 43,709

Submissions included herewith:

- Response to Restriction Requirement (2 pages)
- Transmittal (1 page)

US Serial No. 09/618,235

Filed: July 31, 2000

Inventors: D. N. Rubingh et al.

Attorney Docket No.: 7670

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
RESPONSE/AMENDMENT**

Case Docket No. 7670

**ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231**

Dear Sir:

Transmitted herewith is a **RESPONSE TO RESTRICTION REQUIREMENT/
ELECTION OF SPECIES** for the patent application:

Inventor(s): D. N. Rubingh et al.

Confirmation No. 8644

Serial No.: 09/618,235

Group Art Unit: 1652

Date Filed: 7/18/2000

Examiner: W. W. Moore

Title: Protease Conjugates Having Sterically Protected Epitope Regions

I hereby certify that this correspondence is being facsimile transmitted to: Commissioner for Patents, Washington, D.C. 20231 at (703) 308-4242 in accordance with 37 CFR §§ 1.6(d) and 1.8 on November 2, 2001.

Dara M. Kendall
Name of Attorney

63,709

Registration No.

Signature of Attorney

1. ☒ No additional fee is known to be required.
2. ☐ The fee has been calculated as shown below:

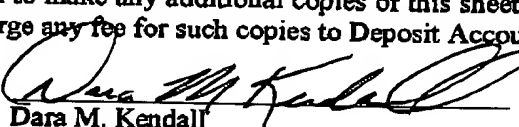
	(Col. 1)		(Col. 2)	(Col. 3)	OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA*	RATE	FEE
TOTAL	* 21	MINUS	** 21	= -0-	x \$18 =	\$-0-
INDEP.	* 01	MINUS	*** 01	= -0-	x \$80 =	\$-0-
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+ \$270 =	\$-0-
					TOTAL	\$-0-

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the highest number of total claims previously paid for is less than 20, write "20" in this space.

*** If the highest number of independent claims previously paid for is less than 3, write "3" in this space.
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

3. ☐ The Commissioner is hereby petitioned under 37 CFR §1.136(a) to grant any extension of time needed for timely response to the Office Action dated in the above-identified application to preserve pendency of said application. The processing fee under 37 CFR §1.17 has been determined as follows: \$ for a -month extension of time.
4. The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 16-2480. A duplicate copy of this sheet is attached.
 - a. ☒ Any patent application processing fees under 37 CFR §1.16.
 - b. ☒ Any patent application processing fees under 37 CFR §1.17.
5. The Commissioner is hereby authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to Deposit Account No. 16-2480.


Dara M. Kendall
Attorney for Applicants
Registration No. 43,709
Tel. No. (513) 626-1789

November 2, 2001

Customer No. 27740